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09/344,010	06/25/1999	STEVEN JEROME MOORE	122995-43-34	8566

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05/13/2003

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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/344,010

Applicant(s)

MOORE, STEVEN JEROME

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/03/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-21 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-16, 18-21 and 26-31 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 9.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on February 3, 2003. In the
5 amendment, claims 22-25 were canceled, claims 8, 10-12, 15, 17, and 19-21 were amended, and
claims 28-31 were newly added. Accordingly, claims 8-21 and 26-31 remain for examination.

Claim Objections

2. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for
10 failing to further limit the subject matter of a previous claim. Applicant is required to cancel the
claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the
claim(s) in independent form.

Re claim 18, there is no "product" defined in claim 15. Even if the Applicant rephrases
the claim "The item of the process of claim 15", the item is already described in claim 15, and
15 claim 18 would fail to further limit the subject matter of a previous claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

20 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing
to particularly point out and distinctly claim the subject matter which applicant regards as the
25 invention.

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Re claim 8, claim 8 recites the limitation "said good" in line 9. There is insufficient antecedent basis for this limitation in the claim. It appears that the Applicant missed an occurrence of "good" while changing the term "good" to "item" in amending claims.

Appropriate correction is required. Applicant is respectfully suggested to check for other
5 typos or informalities in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10 A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipate by Fahner et al.
15 (US 4,822,973, of record).

Fahner teaches a method for encoding concealed identifiers on an item, the method includes directing electromagnetic laser beams from laser 10 to a molten plastic material 14 on a part, the beams forming a unique identifier (see figures 3 and 4 and col. 4, lines 24-29).

20 *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

25 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 8-11, 15, 18-21, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al. (US 5,434,394, of record) in view of Collier (US 5,646,365, of record).

5 Roach teaches a computer assisted method of recording the identity of a purchaser at a retail setting. A customer selects a good to purchase and scans a bar code 68 on the good with scanner 18 or at POS terminal 16, the bar code known to identify the type of good, as well as its manufacturer. An operator at the terminal 16 accepts from the customer an optically encoded identity card 66. A card reader in the terminal reads the card in tandem with the bar code on the
10 good, the information being correlated into a database to be shared by a computer headquarters or other retail systems (see figure 1 and col. 6, lines 28+). A sales receipt can be printed out by the terminal to reflect the purchase. In addition, the customer may also wish for the good to be delivered to his/her address. A telecommunications network ring 34 provides a means of digitally sending information relating to the good, purchaser, and delivery instructions to and
15 from a headquarters network 8 or to a warehouse 40 (see figures 1 and 2, col. 3, line 27 – col. 4, line 6, col. 5, lines 8-17). Moreover, in the embodiment disclosed in Roach, a product such as component parts of PC (i.e. monitors, speakers, headphones or other component parts or peripherals of a product) or other electronic goods can certainly be considered as add-on items.

However, it is not specified that the good is enclosed within a package, the package
20 having a bar code, which is correlatable with the good's bar code and is instead scanned at the time of purchase.

Collier teaches the purchasing of gun bullets, the bullets having a bar-coded good identifier therein under an outer surface of the bullet. The good identifier reflects the type of

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bullet, the lot, and manufacturer of the bullet. At the time of purchase, a customer would provide proper identification, to be cataloged with a bar code read from the package containing the bullets. These information would be held within a national computer database. The bar code on the package would correlate with the bar code in the bullet (see figures 1 and 2, and col. 3, lines 5 45-64). Collier reiterates that it is well known in the art of retail to scan both a good and the good's package in tandem with the identity of a purchaser. Such an act provides efficient inventory tracking as to what items are present within a package, and in the realm of gun/ammunition purchasing, allows secure and monitored purchasing of regulated items. Thus, it would have been obvious to one of ordinary skill in the art to provide such good/package 10 identification. As shown in figure 4a, product data can include dimensional information, which is a characteristic of the product.

6. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al. as modified by Collier, further in view of Moore (US 5,592,561). The teachings of Roach 15 as modified by Collier have been discussed above.

However, it is not taught that the good identifier is invisible to visible light. Such a step in manufacturing is well known in the art, as Moore teaches the authentication of a good, wherein a code, possibly a bar code (col. 15, lines 37-38), is affixed to the good, the code not observable under visible light and can be readable under non-visible light (col. 3, lines 33-49). It 20 would have been obvious to one of ordinary skill to employ this well-known tactic, as it prevents an unauthorized person from readily viewing pertinent data regarding an item, which could lead to improper tampering or duplication of that data.

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7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al. as modified by Collier, further in view of Lane (US 5,623,552, of record). The teachings of Roach as modified by Collier have been discussed above.

However, it is not taught that the card is smart card, with the ability to be self-

5 Authenticating.

Lane teaches a smart card, that can be used at a plurality of locations, the card containing a microprocessor and means for self authentication and identification of a card holder (see figures 1 and 2, col. 1, lines 16-28).

This card is primarily used for the identification of a cardholder at the time of purchasing
10 a good or service. It would have been obvious to one of ordinary skill in the art to provide such a card, as the smart card processor allows more data to be stored within the memory of the card and the authentication means allows the cardholder to verify identity without extensive assistance from a retail terminal and/or the terminal's operator. When purchasing goods at a retail terminal, as customer would enjoy the ability to identify his or herself in an expeditious
15 manner, as the self-authenticating card would provide.

Allowable Subject Matter

8. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and
20 any intervening claims.

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9. The following is a statement of reasons for the indication of allowable subject matter: the claims are directed at an apparatus and the method for purchase product security. Product tracking utilizing various tags such as barcode, IC chips, and more recently, radio frequency tag is gaining wide acceptance in many industries. Volume of encodeable information in such medium is increasing and customized as desired by the system requirements or characteristics. Encoding lot number or manufacturing locations in the barcode is also known. However, the cited references, taken alone or in combination, fails to suggest or teach a scheme wherein the position of the code on a product is associated with the lot in which the product is manufactured as set forth in the claims.

10

Response to Arguments

10. Applicant's arguments filed on February 3, 2003 have been fully considered, but they are not persuasive.

In response to rejections in the remarks section, Applicant kindly distinguished the

15 Examiner's positions and the Applicant's position. Applicant traverses the rejection of claims 26 and 27. In doing so, the Applicant asserted that the Fahner patent does not teach or suggest directing the waves at a material in a molten or semi-molten state. Applicant kindly provided definition of the term "thermoplastic" as "capable of softening or fusing when heated and of hardening again when cooled" (See page 11, second paragraph). In view of such definition, it is
20 the Examiner's view that "thermoplastic" can be broadly interpreted as "semi-molten", as recited in claims 26 and 27. In injection molding process, molten (or softened) plastic is poured into a

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cavity, or the plastic is treated (usually heated) to be in soft state, and additional shaping process is applied.

Upon review of the Roach patent and Applicant's argument pertaining to rejection of claim 17, the Examiner made subject matter disclosed in claim 17 an allowable subject matter.

5 In the remarks, Applicant additionally traverses rejections under 35 U.S.C. 103(a) (See page 12 thereafter of Applicant's remarks).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,
10 suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

For other subject matters amended or newly added, it is the Examiner's position that the
15 previously cited reference to Roach still reads on those elements as indicated in paragraph 4.

The amended claims and remarks describing the Applicant's positions have been given careful considerations, but they are not persuasive, and therefore, the Examiner has made this Office Action final.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
5 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
10 however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru
15 Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

20 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that
25 sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

5

Ahshik Kim
Patent Examiner
Art Unit 2876
May 8, 2003

10



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